



## PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yuki SASAKI et al.

Group Art Unit: 1617

Application No.: 10/015,611

Examiner: L. Wells

Filed: December 17, 2001

Docket No.: 111482

For: RESIN POWDER FOR DERMATOLOGIC COMPOSITION, SKIN CLEANSING AGENT AND COSMETIC COMPOSITION USING THE POWDER, AND PREPARATION PROCESS OF THE POWDER

## REQUEST FOR RECONSIDERATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the August 22, 2003 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

### I. Restriction Requirement

Claims 17-22 are withdrawn from consideration as drawn to a non-elected invention. However, Applicants maintain their traversal with respect to claim 22.

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Id.

In the present application, the method claim of Group III (claim 22) includes all of the limitations of the product of Group I. In particular, claim 22 depends directly from claim 1, and

thus includes all of its limitations. Since the method claim of Group III includes the limitations of the product claims of Group I, the method claim must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

#### I. Rejection under §102

The Office Action rejects claims 1-4 and 7-17 under 35 U.S.C. §102(a) over JP 2001-151639 (JP '639). Applicants respectfully traverse the rejection.

Independent claim 1 is directed to a resin powder for a dermatologic composition, which comprises resin particles having (1) an average volume particle size of 2.0 to 20.0  $\mu\text{m}$ , (2) a shape factor SF1 of 110 to 140 and (3) an average volume particle size distribution GSD<sub>v</sub> of 1.3 or less. According to such a composition, sufficient spreadability and adhesion upon application can be attained. JP '639 does not teach this resin powder as claimed.

JP '639 describes a particulate polystyrene having a particle size distribution (CV value) of 15% and an average particle size of 4.8  $\mu\text{m}$  (see Example 1). However, contrary to the position taken in the Office Action, the JP '639 resin particles do not have the same physical properties as the claimed particles. For instance, since JP '639 produces its particulate polystyrene without controlling the heating conditions, etc., for controlling agglomeration, the resulting particles are substantially spherical. As shown in the enclosed Rule 132 Declaration, the JP '639 polystyrene has a shape factor SF1 value of 105, and thus does not fall within the claimed SF1 range of 110 to 140. For this reason alone, JP '639 does not teach, and does not anticipate, a resin powder having each and every feature as claimed.

Furthermore, as detailed in the Declaration, although the substantially spherical particles taught by JP '639 may exhibit good spreadability upon application, with smoothness

and spreadability values of 4.3 - 4.5, they concomitantly exhibit poor affinity for the skin. The measured JP '639 particle affinity values of 2.0 - 2.9 are far inferior to the value of 4.9 measured for Examples 1 and 11 of the present application. Because the JP '639 particles have insufficient adhesion and/or insufficient affinity to the skin, they tend to cause makeup to come off, as detailed in the present specification (see page 2, lines 1-11). On the other hand, JP '639 does not even recognize this problem and does not teach or suggest the advantageous effects of the presently claimed resin composition. A resin powder having particulate resin as defined by the claimed features and claimed ranges has the advantageous effects of both excellent spreadability and superior adhesion attained simultaneously. These features, ranges and benefits are not taught by JP '639.

For all of these reasons, JP '639 does not teach, and does not anticipate, the resin powder of claim 1, and claims 2, 3, and 7-17 dependent thereon. Applicants respectfully request reconsideration and withdrawal of the rejection.

## **II. Rejection under §103**

The Office Action rejects claims 5-6 under 35 U.S.C. §103(a) over JP '639 in view of JP 06070702 (JP '702). Applicants respectfully traverse the rejection.

Dependent claims 5 and 6 are directed to the resin powder of claim 1, further featuring a defined number-average molecular weight range. The combined teachings of JP '639 and JP '702 would not have taught or suggested to one of ordinary skill in the art a resin powder as claimed.

First, as detailed in the above remarks, JP '639 does not teach, and further does not suggest, a resin powder having a shape factor SF1 of 110 to 140. JP '702 does not remedy the deficiencies of JP '639. JP '702 fails to teach or suggest anything about regulating the shape factor SF1 to 110 to 140. JP '639 and JP '702 do not provide any motivation for altering and controlling the shape factor SF1, and do not teach or suggest any benefits provided thereby.

Second, JP '702 discloses a silk powder reportedly having a molecular weight of 500 to 100,000. The powder, however, has a particle size of from 30 to 100  $\mu\text{m}$ , and thus falls outside the particle size range as claimed (see JP '702 at paragraph 0012). Moreover, a silk powder having a particle size exceeding 20  $\mu\text{m}$  gives the user a foreign body sensation and further tends to induce the cosmetic makeup to come off, as detailed in the present specification (see page 5, lines 11-14).

Third, JP '702 fails to teach or suggest anything about regulating the shape factor SF1 to 110 to 140 and the average volume particle size distribution GSDv so as not to exceed 1.3. Furthermore, JP '702 does not teach or suggest the advantageous effects of simultaneously attaining spreadability upon application and affinity to the skin by using the particulate resin as defined by the ranges as claimed.

For all of these reasons, the combination of JP '639 and JP' 702 would not have taught or suggested, and would not have rendered obvious to one of ordinary skill in the art, the resin of claims 5 and 6. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:HJV/amw

Attachment:

Executed Declaration Under 37 C.F.R. §132

Date: December 19, 2003

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